

DETAILED ACTION

Response to Amendment

PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/James A. Kramer/
Supervisory Patent Examiner, Art Unit 3693

This Office Action is responsive to Applicant's amendment and request for reconsideration of application 09/965,071 (09/27/01) filed on 08/10/09.

Claim Interpretation

1. In determining patentability of an invention over the prior art, all claim limitations have been considered and interpreted as broadly as their terms reasonably allow. See MPEP § 2111.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Pruter*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). See MPEP § 2111.

2. All claim limitations have been considered. Additionally, all words in the claims have been considered in judging the patentability of the claims against the prior art. The following language is interpreted as not further limiting the scope of the claimed invention. See MPEP 2106 II C.

Language in a method claim that states only the intended use or intended result, but the expression does not result in a manipulative difference in the steps of the claim. Language in a system claim that states only the intended use or intended result, but does not result in a structural difference between the claimed invention and the prior art. In other words, if the prior art structure is capable of performing the intended use, then it meets the claim.

Claim limitations that contain statement(s) such as “*if, may, might, can could*”, as optional language. As matter of linguistic precision, optional claim elements do not narrow claim limitations, since they can always be omitted.

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Claim limitations that contain statement(s) such as “*wherein, whereby*”, that fail to further define the steps or acts to be performed in method claims or the discrete physical structure required of system claims.

USPTO personnel should begin claim analysis by identifying and evaluating each claim limitation. For processes, the claim limitations will define steps or acts to be performed. For products, the claim limitations will define discrete physical structures or materials. Product claims are claims that are directed to either machines, manufactures or compositions of matter. See MPEP § 2106 II C.

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) “adapted to” or “adapted for” clauses,
- (C) “wherein” clauses, or
- (D) “whereby” clauses.

See MPEP § 2106 II C.

3. Independent claims are examined together, since they are not patentable distinct. If applicant expressly states on the record that two or more independent and distinct inventions are claimed in a single application, the Examiner may require the applicant to elect an invention to which the claims will be restricted.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims are 1-2 and 4-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. .

Claims 1-2 and 4-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for a method to be considered a "process" under 101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *In re Bilski*, 88 USPQ2d 1385, 1391 and 1396 (2008).

Re Claims 1 and 4: The process steps recited in the body of the claim may be performed by a human operator alone and have not been tied to another statutory class.

NOTE: Applicant should clarify which steps are done "by a computer", "by a processor" etc.. Please note incorporation of another statutory class in just the preamble, or in non-critical steps (e.g., just receiving data) may be insufficient to overcome this rejection.

Dependent claims are rejected based on the same rationale as the claims from which they depend.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 13-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re Claim 13: The claim recites "further including means for." It is unclear by the language "further including" what is being added by the limitation. Specifically, since Applicant does not use this language in any of the other limitations, the Examiner does not understand why it is being used here. Does Applicant intend to add a structural limitation of the system at whole, or is the limitation intended to modify a previously claimed limitation. Since the limitation renders the patentable scope of the claim unclear, the Examiner finds the claim indefinite and request modification of the claim to more clearly and distinctly claim the invention.

Also, the use of "means for" indicates the invocation of 112 6th paragraph. The Examiner can not find definite structural support in the specification for the "means for automatically relaxing search criteria." The Examiner requests that Applicant indicate where the support for the means for limitation may be found in the specification.

Dependent claims are rejected based on the same rationale as the claims from which they depend.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 4, 5, 6, 12, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette, US Pat. No. 5,991,751 in view of Collins, US Pat. No. 6,061,681.

Re Claim 4: Rivette discloses in an on-line service, a method for screening financial investment opportunities, comprising the steps of:

searching a financial database, including data for a plurality of companies, for data records associated with at least one company based upon a financial search criteria and retrieving the results thereof (Rivette, abstract, col. 1, line 1+ - col. 4, line 30; col. 10, lines 8+ - col. 13, line 24; col. 25, line 39+ - col. 30, line 6 searching module; Figs.

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1,2,4,6; abstract; col. 3, line 59+ - col. 4, line 4; col. 10, lines 17-39; col. 11, lines 1-7; col. 12, lines 44-52; col. 12, lines 65+ - col. 13, line 7; col. 15, lines 37-45; col. 16, lines 42-52; and col. 21, lines 59+ - col. 22, line 6 refs. non-patent information, financial information, databases) ;

searching an intellectual property database, including data for a plurality of companies, for data records associated with the at least one company based upon an intellectual property search criteria and retrieving the results thereof (Rivette, abstract, col. 1, line 1+ - col. 4, line 30; col. 10, lines 8+ - col. 13, line 24; col. 25, line 39+ - col. 30, line 6 searching module; Figs. 12a-m; abstract; col. 3, line 59+ - col. 4, line 3; col. 4, line 15-21; col. 10, lines 8-16 and lines 45-48; col. 16, lines 53-67 ref. patent information).

combining the results of the financial database searching step and the intellectual property database searching step to determine common results on a company basis (Rivette, Fig. 7, col. 2, lines 61+ - col. 3, line 9; col. 11, lines 1-7; col. 12, lines 43-52; col. 13, lines 1-11; col 20, lines 12-21 “automatically analyzing the patent information 204 in conjunction with the financial information 216”); and

depicting the combined results (Rivette, Fig. 7, col. 2, lines 61+ - col. 3, line 9; col. 11, lines 1-7; col. 12, lines 43-52; col. 13, lines 1-11; col 20, lines 12-21 “automatically analyzing the patent information 204 in conjunction with the financial information 216”).

Rivette fails to explicitly disclose:

analyzing the number of common results on a company basis to determine if the number is greater than zero, and

if not relaxing the search criteria employed in at least one of the searching steps

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and rerunning the searches so as to obtain a non-zero number of common results.

Collins discloses:

analyzing the number of common results on a company basis to determine if the number is greater than zero (Collins, claims 1, 3, 10, 11, 12 and 13), and if not relaxing the search criteria employed in at least one of the searching steps and rerunning the searches so as to obtain a non-zero number of common results (Collins, claims 1, 3, 10, 11, 12 and 13).

Limitations in the preamble

The recitations occurring in the preamble have not been given patentable weight. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Field of Use/Intended Use

It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In the instant case, Rivette is in the same field of endeavor and pertains to a method, system and computer program product comprising both patent and non-patent

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(i.e., financial) databases and associated search and reporting functions. Black is similarly in the same field of endeavor and as it relates to finance and relevant financial data. In the instant case, Collins addresses the particular problem to be solved which is in a database environment describing the relaxation of search criteria until results are found.

Nonfunctional Descriptive Material What the search criteria comprises and what the records comprise are nonfunctional descriptive material. It has no bearing on steps or acts performed or the functionality of the system. Nothing about steps or acts performed is unique to financial databases and/or intellectual databases. See remarks supra regarding claim interpretation.

Descriptive material (e.g. music, literature, art, photographs and mere arrangements or compilations of facts or data) that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. 101. That is this type of descriptive material called nonfunctional descriptive material whether or not stored on a medium is not statutory. See MPEP §2106.01

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Rivette by adopting the teachings of Collins to provide analyzing the number of common results on a company basis to determine if the number is greater than zero, and if not relaxing the search criteria employed in at least one of the searching steps and rerunning the searches so as to obtain a non-zero number of common results.

As suggested by Rivette one would have been motivated to use publicly available patent related information and non-patent related information (e.g., financial information) to make business decisions.

. The claimed invention applies prior art elements according to known methods to yield predictable results; applies a known technique to a known device (method, or product) ready for improvement to yield predictable results; and known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art. Thus, the claimed subject matter likely would have been obvious under KSR. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Re Claim 5: Rivette in view of Collins discloses the claimed invention supra and Rivette further discloses wherein the step of relaxing the search criteria is accomplished without user intervention (Rivette, col. 25, line 39+ - col. 30, line 6 searching module).

Re Claim 6: Rivette in view of Collins discloses the claimed invention supra and Rivette further discloses maintaining the financial database data records and the intellectual property database records, wherein the step includes periodically launching an automated search of network resources to locate and update financial and intellectual property information (Rivette, col 16, line 19+ -col. 22, line 24 databases; col. 25, line 39+ - col. 30, line 6 searching module); and storing the updated information in the respective database (Rivette, col 16, line 19+ -col. 22, line 24 databases; col. 25, line 39+ - col. 30, line 6 searching module).

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Re Claim 13: Rivette discloses a system for screening financial investment opportunities, comprising (Rivette, Figs. 3,4,5,6; col. 13, line 26+ - col. 15, line 23): a computer platform responsive to user input including access to at least a financial database including data records associated with a plurality of companies and an intellectual property database including data records associated with a plurality of companies (Rivette, Figs. 3,4,5,6; col. 13, line 26+ - col. 15, line 23 computer; col 16, line 19+ -col. 22, line 24 databases; abstract, col. 1, line 1+ - col. 4, line 30; col. 10, lines 8+ - col. 13, line 24); programmable search software, operable by said computer platform, for searching the financial database for data records associated with at least one company based upon a financial search criteria and retrieving the results thereof for storage in a first memory, said programmable search function also being employed for searching the intellectual property database for data records associated with at least one company based upon an intellectual property search criteria and retrieving the results thereof for storage in a second memory (Rivette, col. 14, lines 55-67; col. 15, lines 15-23 software; col. 25, line 39+ - col. 30, line 6 searching module; Figs. 1,2,4,6; abstract; col. 3, line 59+ - col. 4, line 4; col. 10, lines 17-39; col. 11, lines 1-7; col. 12, lines 44-52; col. 12, lines 65+ - col. 13, line 7; col. 15, lines 37-45; col. 16, lines 42-52; and col. 21, lines 59+ - col. 22, line 6 refs. non-patent information, financial information; Figs. 12a-m; abstract; col. 3, line 59+ - col. 4, line 3; col. 4, line 15-21; col. 10, lines 8-16 and lines 45-48; col. 16, lines 53-67 ref. patent information);

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search analysis software, operable by said computer platform, for combining the results of the financial database search and the intellectual property database search to determine common results (Rivette, col. 14, lines 55-67; col. 15, lines 15-23 software; Fig. 7, col. 2, lines 61+ - col. 3, line 9; col. 11, lines 1-7; col. 12, lines 43-52; col. 13, lines 1-11; col 20, lines 12-21 “automatically analyzing the patent information 204 in conjunction with the financial information 216”); and a display device for depicting the common results (Rivette, col. 15, line 5-8 display unit; Fig. 7, col. 2, lines 61+ - col. 3, line 9; col. 11, lines 1-7; col. 12, lines 43-52; col. 13, lines 1-11; col 20, lines 12-21 “automatically analyzing the patent information 204 in conjunction with the financial information 216”).

Rivette fails to explicitly disclose:

further including means for automatically relaxing search criteria employed by the programmable search software so as to obtain a non-zero number of search results.

Collins discloses:

further including means for automatically relaxing search criteria employed by the programmable search software so as to obtain a non-zero number of search results (Collins, claims 1, 3, 10, 11, 12 and 13).

Limitations in the preamble

The recitations occurring in the preamble have not been given patentable weight. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process

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steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Field of Use/Intended Use

It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In the instant case, Rivette is in the same field of endeavor and pertains to a method, system and computer program product comprising both patent and non-patent (i.e., financial) databases and associated search and reporting functions. Black is similarly in the same field of endeavor and as it relates to finance and relevant financial data. In the instant case, Collins addresses the particular problem to be solved which is in a database environment describing the relaxation of search criteria until results are found.

Nonfunctional Descriptive Material What the search criteria comprises and what the records comprise are nonfunctional descriptive material. It has no bearing on steps or acts performed or the functionality of the system. Nothing about steps or acts performed is unique to financial databases and/or intellectual databases See remarks supra regarding claim interpretation.

Descriptive material (e.g. music, literature, art, photographs and mere arrangements or compilations of facts or data) that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of

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matter and should be rejected under 35 U.S.C. 101. That is this type of descriptive material called nonfunctional descriptive material whether or not stored on a medium is not statutory. See MPEP §2106.01

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Rivette by adopting the teachings of Collins to provide further including means for automatically relaxing search criteria employed by the programmable search software so as to obtain a non-zero number of search results.

As suggested by Rivette one would have been motivated to use publicly available patent related information and non-patent related information (e.g., financial information) to make business decisions.

. The claimed invention applies prior art elements according to known methods to yield predictable results; applies a known technique to a known device (method, or product) ready for improvement to yield predictable results; and known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art. Thus, the claimed subject matter likely would have been obvious under KSR. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Re Claim 12: Rivette in view of Collins discloses the claimed invention supra and Rivette further discloses wherein said computer platform includes a client and a server interconnected by a network, and where the financial database and the intellectual property database are stored on devices accessible through said server Rivette, Figs. 3 e.g., clients, network, servers, databases ,4,5,6; col. 13, line 26+ - col. 15, line 23.

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Re Claim 15: Rivette in view of Collins discloses the claimed invention supra and Rivette further discloses wherein said display device is suitable for the display of at least one user-selectable data item to assist with the construction of a search query having both financial search criteria and intellectual property search criteria (Rivette, col. 15, line 5-8 display unit; col. 25, line 39+ - col. 30, line 6 searching module).

Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette in view of Collins as applied to claims 4,6 13 above, and further in view of Black, US Pat. No. 6,012,042.

Re Claim 7: Rivette in view of Collins discloses the claimed invention supra and Rivette further discloses, wherein the updated information includes: financial data (Rivette, col. 25, line 39+ - col. 30, line 6 searching module; Figs. 1,2,4,6; abstract; col. 3, line 59+ - col. 4, line 4; col. 10, lines 17-39; col. 11, lines 1-7; col. 12, lines 44-52; col. 12, lines 65+ - col. 13, line 7; col. 15, lines 37-45; col. 16, lines 42-52; and col. 21, lines 59+ - col. 22, line 6 refs. non-patent information, financial information, databases), and at least one item of intellectual property data selected from the group consisting of Patent Number, Inventor Name, Issue Date, Title, Inventor State, Abstract, Inventor Country, Claims), Attorney or Agent, Description/specification, Assignee Name, Assignee State, Assignee Country, Issued US Classification, International Classification, Application Serial Number, Application Date, Primary Examiner, Assistant Examiner, Parent Case Information, Related US App. Data, US References, Reissue Data Foreign References, Foreign Priority, PCT

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Information, Government Interest, and Application Type (Rivette, col. 25, line 39+ - col. 30, line 6 searching module; Figs. 12a-m; abstract; col. 3, line 59+ - col. 4, line 3; col. 4, line 15-21; col. 10, lines 8-16 and lines 45-48; col. 16, lines 53-67 ref. patent information).

Rivette fails to explicitly disclose:

wherein the updated information includes: at least one item of financial data selected from the group consisting of Stock Price, Price/Earnings Ratio, Current Ratio, Debt/Equity Ratio, Cash/price ratio, Earnings per Share Growth-1Yr, Earnings per Share Growth-1Yr, Insider Trades, Institutional Holdings %, Price/Book Ratio, and Price/cash Flow Ratio,

Black discloses a method, wherein the updated information includes:

at least one item of financial data selected from the group consisting of Stock Price, Price/Earnings Ratio, Current Ratio, Debt/Equity Ratio, Cash/price ratio, Earnings per Share Growth-1Yr, Earnings per Share Growth-1Yr, Insider Trades, Institutional Holdings %, Price/Book Ratio, and Price/cash Flow Ratio (Black, Figs. 3 and 4; col. 1, lines 45-65; and col. 2, lines 8-41 financial information).

. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Rivette and Collins by adopting the teachings of Black to provide in an on-line service, a method for screening financial investment opportunities, comprising the steps of: searching a financial database for data records associated with at least one company based upon a financial search criteria and retrieving the results thereof; searching an intellectual property database for data

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records associated with at least one company based upon an intellectual property search criteria and retrieving the results thereof; combining the results of the financial database searching step and the intellectual property database searching step to determine common results on a company basis; and depicting the combined results.

As suggested by Rivette one would have been motivated to use publicly available patent related information and non-patent related information (e.g., financial information) to make business decisions.

. The claimed invention applies prior art elements according to known methods to yield predictable results; applies a known technique to a known device (method, or product) ready for improvement to yield predictable results; and known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art. Thus, the claimed subject matter likely would have been obvious under KSR. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Re Claim 14: Rivette in view of Collins discloses the claimed invention supra and Rivette further discloses wherein said financial database includes records having financial data (Rivette, col. 25, line 39+ - col. 30, line 6 searching module; Figs. 1,2,4,6; abstract; col. 3, line 59+ - col. 4, line 4; col. 10, lines 17-39; col. 11, lines 1-7; col. 12, lines 44-52; col. 12, lines 65+ - col. 13, line 7; col. 15, lines 37-45; col. 16, lines 42-52; and col. 21, lines 59+ - col. 22, line 6 refs. non-patent information, financial information, databases), and

where said intellectual property database includes records having at least

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one item of intellectual property data selected from the group consisting of Patent Number, Inventor Name, Issue Date, Title, Inventor State, Abstract, Inventor Country, Claims), Attorney or Agent, Description/specification, Assignee Name, Assignee State, Assignee Country, Issued US Classification, International Classification, Application Serial Number, Application Date, Primary Examiner, Assistant Examiner, Parent Case Information, Related US App. Data, US References, Reissue Data Foreign References, Foreign Priority, PCT Information, Government Interest, and Application Type (Rivette, col. 25, line 39+ - col. 30, line 6 searching module; Figs. 12a-m; abstract; col. 3, line 59+ - col. 4, line 3; col. 4, line 15-21; col. 10, lines 8-16 and lines 45-48; col. 16, lines 53-67 ref. patent information).

Rivette fails to explicitly disclose, wherein said financial database includes records having at least one item of financial data selected from the group consisting of Stock Price, Price/Earnings Ratio, Current Ratio, Debt/Equity Ratio, Cash/price ratio, Earnings per Share Growth-1Yr, Earnings per Share Growth-1Yr, Insider Trades, Institutional Holdings %, Price/Book Ratio, and Price/cash Flow Ratio.

Black discloses a system, wherein said financial database includes records having at least one item of financial data selected from the group consisting of Stock Price, Price/Earnings Ratio, Current Ratio, Debt/Equity Ratio, Cash/price ratio, Earnings per Share Growth-1Yr, Earnings per Share Growth-1Yr, Insider Trades, Institutional Holdings %, Price/Book Ratio, and Price/cash

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Flow Ratio (Black, Figs. 3 and 4; col. 1, lines 45-65; and col. 2, lines 8-41 financial information).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Rivette and Collins by adopting the teachings of Black to provide a system, wherein said financial database includes records having at least one item of financial data selected from the group consisting of Stock Price, Price/Earnings Ratio, Current Ratio, Debt/Equity Ratio, Cash/price ratio, Earnings per Share Growth-1Yr, Earnings per Share Growth-1Yr, Insider Trades, Institutional Holdings %, Price/Book Ratio, and Price/cash Flow Ratio, and where said intellectual property database includes records having at least one item of intellectual property data selected from the group consisting of Patent Number, Inventor Name, Issue Date, Title, Inventor State, Abstract, Inventor Country, Claims), Attorney or Agent, Description/specification, Assignee Name, Assignee State, Assignee Country, Issued US Classification, International Classification, Application Serial Number, Application Date, Primary Examiner, Assistant Examiner, Parent Case Information, Related US App. Data, US References, Reissue Data Foreign References, Foreign Priority, PCT Information, Government Interest, and Application Type.

As suggested by Rivette one would have been motivated to use publicly available patent related information and non-patent related information (e.g., financial information) to make business decisions.

The claimed invention applies prior art elements according to known methods to yield predictable results; applies a known technique to a known device (method, or

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product) ready for improvement to yield predictable results; and known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art. Thus, the claimed subject matter likely would have been obvious under KSR. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette, US Pat. No. 5,991,751 in view of Collins, US Pat. No. 6,061,681 and Black, US Pat. No. 6,012,042.

Re Claim 1: Rivette discloses in an on-line financial screening service, a method of searching a financial database, including data for a plurality of companies, and an intellectual property database, including data for a plurality of companies, in order to find securities matching user search criteria and relevant intellectual property, wherein the users access the database over the Internet (Rivette, abstract, col. 1, line 1+ - col. 4, line 30; col. 10, lines 8+ - col. 13, line 24), the method comprising: searching the database for records matching financial search criteria defined by a user (Rivette, Figs. 1,2,4,6; abstract; col. 3, line 59+ - col. 4, line 4; col. 10, lines 17-39; col. 11, lines 1-7; col. 12, lines 44-52; col. 12, lines 65+ - col. 13, line 7; col. 15, lines 37-45; col. 16, lines 42-52; and col. 21, lines 59+ - col. 22, line 6 refs. non-patent information, financial information, databases); and reporting the matching records to the user (Rivette, col. 9, line 65+ -col. 10, line 3 ie., reporting, analyzing and planning; col. 20, lines 42-52).

Rivette fails to explicitly disclose:

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relaxing at least some of the search criteria, until at least a required number of matching records are found, wherein the required number of matching records is never less than one; and

wherein reporting the matching records to the user, includes at least one item of data selected from the group consisting of Stock Price, Price/Earnings Ratio, Current Ratio, Debt/Equity Ratio, Cash/price ratio, Earnings per Share Growth- 1Yr, Earnings per Share Growth-IYr, Insider Trades, Institutional Holdings %, Price/Book Ratio, and Price/cash Flow Ratio.

Collins discloses:

relaxing at least some of the search criteria, until at least a required number of matching records are found, wherein the required number of matching records is never less than one (Collins, claims 1, 3, 10, 11, 12 and 13).

Black discloses:

wherein reporting the matching records to the user, includes at least one item of data selected from the group consisting of Stock Price, Price/Earnings Ratio, Current Ratio, Debt/Equity Ratio, Cash/price ratio, Earnings per Share Growth- 1Yr, Earnings per Share Growth-IYr, Insider Trades, Institutional Holdings %, Price/Book Ratio, and Price/cash Flow Ratio (Black, Figs. 3 and 4; col. 1, lines 45-65; and col. 2, lines 8-41 financial information).

Limitations in the preamble

The recitations occurring in the preamble have not been given patentable weight. A preamble is generally not accorded any patentable weight where it merely recites the

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purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Field of Use/Intended Use

It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In the instant case, Rivette is in the same field of endeavor and pertains to a method, system and computer program product comprising both patent and non-patent (i.e., financial) databases and associated search and reporting functions. Black is similarly in the same field of endeavor and as it relates to finance and relevant financial data. In the instant case, Collins addresses the particular problem to be solved which is in a database environment describing the relaxation of search criteria until results are found.

Nonfunctional Descriptive Material What the search criteria comprises and what the records comprise are nonfunctional descriptive material. It has no bearing on steps or acts performed or the functionality of the system. Nothing about steps or acts performed is unique to financial databases and/or intellectual databases. See remarks *supra* regarding claim interpretation.

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Descriptive material (e.g. music, literature, art, photographs and mere arrangements or compilations of facts or data) that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. 101. That is this type of descriptive material called nonfunctional descriptive material whether or not stored on a medium is not statutory. See MPEP §2106.01

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Rivette by adopting the teachings of Collins and Black to provide relaxing at least some of the search criteria, until at least a required number of matching records are found, wherein the required number of matching records is never less than one; and wherein reporting the matching records to the user, includes at least one item of data selected from the group consisting of Stock Price, Price/Earnings Ratio, Current Ratio, Debt/Equity Ratio, Cash/price ratio, Earnings per Share Growth- 1Yr, Earnings per Share Growth-1Yr, Insider Trades, Institutional Holdings %, Price/Book Ratio, and Price/cash Flow Ratio.

As suggested by Rivette one would have been motivated to use publicly available patent related information and non-patent related information (e.g., financial information) to make business decisions.

. The claimed invention applies prior art elements according to known methods to yield predictable results; applies a known technique to a known device (method, or product) ready for improvement to yield predictable results; and known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art. Thus, the claimed subject matter likely would have been

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obvious under KSR. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Re Claim 2: Rivette in view of Collins and Black discloses the claimed invention *supra* and Rivette further discloses wherein the search criteria is suitable for being delimited between a minimum and maximum (Rivette, col. 25, line 39+ - col. 30, line 6 searching module).

Allowable Subject Matter

Claims 8 and 9 are allowed.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SARA CHANDLER whose telephone number is (571)272-1186. The examiner can normally be reached on M-F, 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571)272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SMC

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